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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Masco Corporation of Indiana

Serial No. 75/819,592

Edgar A. Zarins of Masco Corporation for Masco Corporation of Indiana.

Janice L. McMorrow, Trademark Examining Attorney, Law Office 104 (Sidney Moskowitz, Managing Attorney).

Before Seeherman, Hanak and Hairston, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Masco Corporation of Indiana has appealed from the final refusal of the Trademark Examining Attorney to register SIGNATURE as a trademark for "plumbing products, namely, faucets." Applicant's application was filed on October 12, 1999, alleging use of the mark in commerce on April 1, 1998.

Registration has been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that

applicant's mark so resembles the mark SIGNATURE, previously registered for "shower heads,"¹ as to be likely, when used on applicant's goods, to cause confusion or mistake or to deceive.

Applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested.

With its appeal brief applicant filed a consent agreement between itself and the owner of the cited registration. The Examining Attorney has objected to our consideration of this agreement because it was not properly of record. The Examining Attorney is correct that Trademark Rule 2.142(d) provides that the record in the application should be complete prior to the filing of an appeal. The proper procedure, should an applicant wish to introduce evidence after an appeal is filed, is to request that the Board remand the application to the Examining Attorney for consideration of such evidence. However, Rule 2.142(d) goes on to state that "The Trademark Trial and Appeal will ordinarily not consider additional evidence filed with the Board by the appellant or by the examiner after the appeal is filed." (emphasis added). The Board is not prohibited by the rule from considering such

¹ Registration No. 1,895,578, issued May 23, 1995; Section 8 affidavit accepted; Section 15 affidavit received.

additional evidence, and in this case, for the following reasons, we exercise our discretion and do so.

Generally, when either the applicant or the Examining Attorney wishes to make additional evidence of record after an appeal is filed, he must show good cause for the request. See TBMP § 1207.02. Because a consent agreement "may be highly persuasive of registrability," submitting a consent agreement constitutes good cause. Id. Moreover, the Board will grant a request to suspend and remand for consideration of a consent agreement if the request, accompanied by the consent agreement, is filed at any time prior to the rendering of the Board's final decision on the appeal. Thus, the fact that applicant submitted the consent agreement with its appeal brief does not preclude it from being considered; what applicant failed to do was follow the proper procedure in requesting a remand to make the consent agreement of record.

Given the potentially dispositive effect of a consent agreement, we could, at this point, simply remand the application to the Examining Attorney specifically for the purpose of considering the agreement. However, in this case the Examining Attorney has discussed the probative value of applicant's consent agreement in her appeal brief.

Accordingly, no purpose would be served in remanding the application at this time.

Likelihood of confusion is determined based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in **In re E.I. du Pont de Nemours & Co.**, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

The Examining Attorney has focused her discussion on two of these factors, the marks and the goods. The marks, of course, are identical. As for the goods, applicant acknowledges that faucets and shower heads are complementary, and the Examining Attorney has submitted a number of third-party registrations in which entities have registered their particular marks for both faucets and shower heads.

There is a third duPont factor which plays a significant role when present, and it is present in this case. That is the consent between applicant and the owner of the cited registration. In duPont, the Court stated as follows:

[W]hen those most familiar with use in the marketplace and most interested in precluding confusion enter agreements designed to avoid it, the scales of evidence are clearly tilted. It is at least difficult to maintain a subjective view that confusion will occur when those directly concerned say it won't. A mere *assumption* that

confusion is likely will rarely prevail against uncontroverted evidence from those on the firing line that it is not.

476 F.2d at 1363, 177 USPQ at 568.

The Trademark Manual of Examining Procedure cautions Examining Attorneys as to the weight to be accorded consent agreements:

The Court of Appeals for the Federal Circuit has made it clear that consent agreements should be given great weight, and that the Office should not substitute its judgment concerning likelihood of confusion for the judgment of the real parties in interest without good reason, that is, unless the other factors clearly dictate a finding of likelihood of confusion. **Amalgamated Bank of New York v. Amalgamated Trust & Savings Bank**, 842 F.2d 1270, 6 USPQ2d 1305 (Fed. Cir. 1988); **Bongrain International (American) Corp. v. Delice de France Inc.**, 811 F.2d 1479, 1 USPQ2d 1775 (Fed. Cir. 1987); and **In re N.A.D. Inc.**, 754 F.2d 996, 224 USPQ 969 (Fed. Cir. 1985).

....
TMEP § 1207.01(d)(viii) 3d ed.

The Examining Attorney contends that the consent agreement submitted by applicant is insufficient to establish that confusion is not likely because it does not recite "considerations as to why the parties believe there is no likelihood of confusion, e.g., differences in the goods and applications therefor, the marks, the trade

channels, and prospective customers," nor does it "include a program of action designed to avoid confusion in the future, such as limitations on promotions and manner of distribution, advertising, and product packaging" or "an agreement between the parties to undertake further action, such as executing other agreements as necessary, to carry out the spirit and intent of the original consent agreement." Brief, p. 6.

We certainly agree that provisions such as those described by the Examining Attorney can increase the persuasive value of a consent agreement, although what we must consider is not what is missing from an agreement, but what it contains. In fact, the agreement submitted by applicant states that there are differences in the goods (bathroom accessories versus plumbing products); in the channels of trade; and in the end uses of the products. These include two of the factors listed by the Examining Attorney in her suggestion of what would constitute a persuasive consent agreement. Moreover, applicant has explained that it and the registrant are sister companies, and the consent agreement is signed by Richard G. Mosteller as Vice President of applicant and as Vice President of registrant. Given this close relationship between the companies, the lack of a provision in the agreement that

they will "undertake further action, such as executing other agreements as necessary, to carry out the spirit and intent of the original consent agreement" seems unnecessary.

The Examining Attorney has not addressed the cases, some of which are cited in TMEP § 1207.01(d)(viii) above, in which consents were found to be a major, if not dispositive factor. Rather, the Examining Attorney relies on **In re Mastic Inc.**, 829 F.2d 1114, 4 USPQ2d 1292 (Fed. Cir. 1987). That case involved an application filed under the provisions of Section 44 of the Trademark Act, that is, no use of the mark in the United States was alleged. As a result, the parties' statements as to differences in "established, likely to continue, trade channels," "the lack of actual confusion between the marks," and the length of time and conditions under which there has been concurrent use without evidence of confusion" had no probative value. The Court also pointed out that the agreement in that case provided the registrant's consent only to the registration, and not the use of applicant's mark. In addition, the Court noted that the consent agreement merely parroted the duPont factors, and that this parroting resulted in inconsistent statements, e.g., "the

dissimilarity of the marks as applied to these specific goods" when the marks were identical.

In the present case, on the other hand, applicant has asserted use of the mark in U.S. commerce since 1998.

Thus, we can assume that applicant and registrant have had experience with applicant's actual use of the mark on its goods. Further, considering that applicant and the registrant are sister companies, information about any confusion during the four years of contemporaneous use would certainly have reached the parties.

Decision: The refusal of registration is reversed.